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DOUGHERTY & TROXELL
SUITE 1404
5205 LEESBURG PIKE
FALLS CHURCH VA 22041

MAILED

SEP 15 2011

OFFICE OF PETITIONS

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| In re Patent of | : | |
| Tareq Nasser Albuaijan | : | |
| Patent No.: 6,435,022 | : | |
| Issue Date: 08/20/2002 | : | |
| Application No. 09/779661 | : | |
| Filing or 371(c) Date: 02/09/2001 | : | ON PETITION |
| Title of Invention: | : | |
| PARTIAL STROKE TESTING SYSTEM | : | |

This is a decision on the petition under 37 CFR § 1.378(b), filed August 24, 2011, to reinstate the above-identified patent.

The petitions are **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The patent issued August 20, 2002. Patentee could have paid the three and one half (3½) year maintenance fee between August 20, 2005, and February 20, 2006, without a surcharge, or within the six (6) month grace period between February 21, 2006, and August 20, 2006. Patentee failed to do so; accordingly, the patent became expired on August 21, 2006. It is also noted that the seven and one half (7½) year maintenance fee was not timely paid.

The present petition

Petitioner files the present petition and provides, inter alia, that on June 27, 2002 petitioner paid an issue fee and on an Issue Fee Transmittal Form sent from the U.S.P.T.O. which was addressed to Dougherty and Troxell. Petitioner moved from Dougherty and Troxell to Dennison Schultz

and Dougherty. Petitioner does not provide the date of the move from Dougherty and Troxell to Dennison Schultz and Dougherty¹.

Petitioner provides further that this Office continued to send correspondence to the prior address of the Dougherty and Troxell firm, after receiving a change of address on March 14, 2001. Petitioner avers that had the Notice of Patent Expiration been reported to Dennison Schultz and Dougherty, it would have been immediately reviewed in view of standing instructions from the Kuwait Foundation for the Advancement of Sciences.

In support of the present petition, petitioner files the Declaration of Ricardo A. Young, docketing manager for Lowe, Hauptman, Berner and Ham, LLP, since September 2004. Mr. Young provides, in relevant part, that petitioner herein, attorney David Dougherty joined the firm on or about May 1, 2006. Mr. Young provides further that he was tasked with manually entering all of attorney Dougherty's records in the firm's database, a task that took him until the end of 2006. However, the record for the present patent was not transferred to the firm during the transition period, and was not transferred to the firm's custody until sometime during the year 2007 or later and was shipped with additional abandoned cases and miscellaneous communications from Mr. Dougherty's previous firm. At that time, Mr. Young notes, the patent had already expired for failure to pay the first maintenance fee. Young Declaration at p.2.

In further support of the present petition, petitioner files the Declaration of Daphne A. Ward (Ward Declaration). Ms. Ward provides, in relevant part, that during the period from May 2002 and for several months thereafter, she worked part-time for Mr. Dougherty. Ms. Ward notes that Eric Taylor was the docket manager, and Doreen Tillman was the full-time secretary to Mr. Dougherty. Based on Ms. Ward's memory, she provides that all files that she was responsible for were properly docketed and entered into the electronic docketing system. Ms. Ward does not state whether she was responsible for docketing and entering into the electronic database the present patent. Ms. Ward also believes that all of Mr. Dougherty's files at Dougherty and Troxell were moved to Dennison Schultz and Dougherty. Ms. Ward provides further that for a period of several months following Mr. Dougherty's move from Dennison Schultz and Dougherty and MacDonald firm to the Lowe Hauptman Ham & Berner, LLP, she entered docketing information from Mr. Dougherty's files into the electronic docketing system of Lowe Hauptman Ham & Berner, LLP, and that to the best of her knowledge, each of Mr. Dougherty's files that she entered into the electronic docketing system of Lowe Hauptman Ham & Berner, LLP were properly docketed into the Lowe Hauptman Ham & Berner, LLP docket.

Applicable Law, Rules and MPEP

35 U.S.C. § 41(c)(1) states:

The Commissioner may accept the payment of any maintenance fee required subsection (b) of this section which is made within twenty-four months after the six-month grace period if this delay is shown to the satisfaction of the Commissioner to have been unintentional, or at any time

¹ Regarding the chronology, Petitioner does provide that "[a]t the Dougherty and Troxell firm, the Dennison Schultz and Dougherty firm, Dennison Schultz Dougherty and MacDonald firm and subsequently at the Lowe Hauptman Ham and Berner, LLP firm, [Petitioner] maintained [his] files separately from firm files to the extent that all of [his] files were together...."

after the six-month grace period if the delay is shown to the satisfaction of the Director to have been unavoidable.

37 CFR 1.378(b) provides that a patent may be reinstated at any time following expiration of the patent for failure to timely pay a maintenance fee. A petition to accept late payment of a maintenance fee, where the delay was unavoidable, must include:

- (A) the required maintenance fee set forth in 37 CFR 1.20(e)-(g);
- (B) the surcharge set forth in 37 CFR 1.20(i)(1); and
- (C) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent.

The required showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly. Furthermore, an adequate showing requires *a statement by all persons with direct knowledge of the cause of the delay*, setting forth the facts as they know them. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. (Emphasis supplied).

As language in 35 U.S.C. § 41(c)(1) is identical to that in 35 U.S.C. § 133 (i.e., “unavoidable” delay), a late maintenance fee for the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. § 133. *See Ray v. Lehman*, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995) (quoting *In re Patent No. 4,409,763*, 7 USPQ2d 1798, 1800 (Comm’r Pat. 1988), *aff’d sub nom. Rydeen v. Quigg*, 748 F. Supp. 900, 16 USPQ2d 1876 (D.D.C. 1990), *aff’d*, 937 F.2d 623 (Fed. Cir. 1991) (table), *cert. denied*, 502 U.S. 1075 (1992)). *See* MPEP § 711.03(c) for a general discussion of the “unavoidable” delay standard.

As 35 U.S.C. § 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. § 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. *Ray*, 55 F.3d at 609, 34 USPQ2d at 1788. That is, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. *Id.* Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In view of the requirement to enumerate the steps taken to ensure timely payment of the maintenance fee, the patentee’s lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee Reminder do not constitute unavoidable delay. *See Patent No. 4,409,763*, *supra*. *See also* Final Rule entitled “Final Rules for Patent Maintenance Fees,” published in the *Federal Register* at 49 Fed. Reg. 34716, 34722-23 (August

31, 1984), and republished in the Official Gazette at 1046 Off. Gaz. Pat. Office 28, 34 (September 25, 1984). Under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office. Thus, evidence that despite reasonable care on behalf of the patentee and/or the patentee's agents, and reasonable steps to ensure timely payment, the maintenance fee was unavoidably not paid, could be submitted in support of an argument that the delay in payment was unavoidable.

An error in a docketing system could possibly result in a finding that a delay in payment was unavoidable if it were shown that reasonable care was exercised in designing and operating the system and that the patentee took reasonable steps to ensure that the patent was entered into the system to ensure timely payment of the maintenance fees.

A showing of unavoidable delay will (in addition to the above) require: (1) evidence concerning the procedures in place that should have avoided the error resulting in the delay; (2) evidence concerning the training and experience of the persons responsible for the error; and (3) copies of any applicable docketing records to show that the error was in fact the cause of the delay. See MPEP § 711.03(c)(III)(C)(2).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that:

- (A) the error was the cause of the delay at issue;
- (B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and
- (C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See In re Egbers, 6 USPQ2d 1869, 1872 (Comm'r Pat. 1988), rev'd on other grounds sub nom., Theodor Groz & Sohne & Ernst Bechert Nadelfabrik KG v. Quigg, 10 USPQ2d 1787 (D.D.C. 1988); In re Katrapat, 6 USPQ2d 1863, 1867-68 (Comm'r Pat. 1988).

Opinion

As provided in the patent statute and rules, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Id.

Patentee is advised that under the statutes and rules, the Office has no duty to notify patentees of the requirement to pay maintenance fees or to notify patentees when the maintenance fees are due. It is solely the responsibility of the patentee to assure that the maintenance fee is timely paid

to prevent expiration of the patent. The lack of knowledge of the requirement to pay a maintenance fee and the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office.

Here, Petitioner provides that had the Notice of Patent Expiration been reported to Dennison Schultz and Dougherty, it would have been immediately reviewed in view of standing instructions from the Kuwait Foundation for the Advancement of Sciences. However, Petitioner does not provide any steps taken to ensure timely payment of the maintenance fee. (Emphasis supplied). As stated supra, an adequate showing that the delay in payment of the maintenance fee at issue was “unavoidable” within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent, and where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b). Petitioner was responsible for payment of the 3½ year maintenance fee; however, Petitioner has not provided any showing as to any steps taken to ensure timely payment of the maintenance fee. Instead, Petitioner relied upon this Office to send maintenance fee reminders and/or Notice of Expiration. As stated supra, the failure to receive the Maintenance Fee Reminder will not shift the burden of monitoring the time for paying a maintenance fee from the patentee to the Office,

Moreover, Petitioner has not provided any statement as to the cause of the delay, or any statements from any persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner has filed several Declarations (Young and Ward Declaration’s); however, the Declarant’s aver no knowledge of the cause of the delay in paying the maintenance fee, and instead aver no knowledge of any irregularities in docketing of maintenance fees. Moreover, Mr. Young provides that the present patent was not transferred to the firm’s custody until sometime during the year 2007 or later and at that time the patent had already expired for failure to pay the first maintenance fee

Conclusion

The evidence has been considered; however, Petitioner has failed to demonstrate that the failure to timely pay the maintenance fee was unavoidable.

Petitioner’s current options

I. Petitioner may file a request for reconsideration.

If reconsideration of this decision is desired, a petition for reconsideration must be filed within TWO (2) MONTHS from the mail date of this decision. The petition for reconsideration should be entitled “Petition for Reconsideration under 37 CFR 1.378(b).” Any petition for reconsideration of this decision must be accompanied by a non-refundable petition fee of \$400 as set forth in 37 CFR 1.17(h).

After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for

reconsideration. The Commissioner's decision will be based solely on the administrative record in existence. Petitioner should remember that it is not enough that the delay was unavoidable; petitioner must prove that the delay was unavoidable. A petition will not be granted if petitioner provides insufficient evidence to 'show' that the delay was unavoidable. Therefore, if a request for reconsideration is filed, it must establish that the entire delay in the submission of the maintenance fee was unavoidable.

II. Petitioner may request a refund of the maintenance fee which accompanied the petition.

Petitioner may request a refund of the maintenance fee by writing to the Office of Finance, Refund Section, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Finally, a review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
 Director for Patents
 PO Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 Attn: Office of Petitions

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries concerning this Decision should be directed to the undersigned at (571) 272-3232.

/DLW/

Derek L. Woods
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